

**REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants wish to address the showing required by 37 CFR § 1.116(b) as to why this amendment is necessary and was not presented earlier. This amendment is responsive to new grounds of rejection contained in the final rejection and, therefore, is clearly necessary. Moreover, since this is first substantive response to the final rejection, obviously this amendment could not have been presented earlier. In view of the foregoing, Applicants respectfully submit that a proper showing has been made. Therefore, Applicants respectfully request that the Examiner enter and consider this amendment.

With the amendments above, the substance of claim 7 has been incorporated into claim 1 without prejudice to pursuing the broader subject matter in a divisional application. As a result, claims 6 and 7 are now canceled, thereby offering further grounds for entering this amendment since it (i) results in a reduction of claims and (ii) reduces issues for possible appeal since, as will be explained in further detail below, it clearly removes the prior art rejections.

Claim 11 has been revised to make it consistent with claim 1 as amended. Support for the concept that the compounds of formula (IV) can serve as solvents can be found at page 15, lines 9-11, of the original specification.

Claims 12 and 13 have been revised to recite positive method steps.

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Amendment Under 37 CFR § 1.116 filed September 19, 2007

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Applicants do not believe that any of the changes introduce new matter. An early notice to that effect is earnestly solicited.

Claims 1-4 and 6-17 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants point out that the specification incorporates by reference well known technology, i.e., the basic nanoparticle synthesis, including the starting materials used therein. Thus, Applicants refer, for example, to numbered paragraphs [0003]-[0006] of US 2006/0063155, which is the publication of the instant application, where prior art sources for the basic nanoparticle synthesis are provided. One of the sources mentioned is WO 02/20696, which is the international counterpart of the Haubold publication on which the Examiner relies to reject certain of the instant claims. In short, the basic nanoparticle synthesis, including the needed starting materials, was well known in the prior art, and the instant specification provides exemplary sources where the knowledge can be found. In addition, the specification provides working examples, giving further examples of the preparation of nanoparticles according to the further teachings of the present invention. As such, not only would the phrase "starting material" clearly be understood by persons having ordinary skill in the art, but the specification is fully enabling. In this regard, Applicants respectfully remind the Examiner that "the specification need not disclose what is well-known in the art and *preferably omits* that which is well-known to those skilled and already available to the public." MPEP § 2164.05(a).

Claims 2, 4, 14 and 15 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. In response, Applicants respectfully submit that the wording "can also be doped," clearly and unequivocally conveys to persons skilled in the

art that the nanoparticles are either undoped or doped. Indeed, the wording "can also be doped," suggests that doping is only an option, and that, therefore, the nanoparticles can also be undoped.

Claims 1-3 and 6 were rejected under 35 USC § 102(e) as being anticipated by Haubold et al. ("Haubold"), US 2003/0032192. In response, as noted above, Applicants have incorporated the subject matter of claim 7 into main claim 1. Since claim 7 was not subject to this rejection, claim 1 as amended should also be free of this rejection. As the other claims depend on claim 1, they also should be free of this rejection.

Claims 4 and 14-15 were rejected under 35 USC § 103(a) as being obvious over Haubold. In response, as noted above, Applicants have incorporated the subject matter of claim 7 into main claim 1. Since claim 7 was not subject to this rejection, claim 1 as amended should also be free of this rejection. As the rejected claims depend on claim 1, they also should be free of this rejection.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
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